

REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and following remarks is respectfully requested.

A. Status of the Claims and Explanation of Amendments

Claims 1-13 are pending and are rejected. Claims 1, 2, 6-11 and 13 are rejected under 35 U.S.C. §102(b) as allegedly being unpatentable by U.S. Patent No. 6,323,989 to Jacobson et al. (hereinafter "Jacobson"). (5/17/06 Office Action, p.2). Claims 3, 4, and 5 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Jacobson in view of U.S. Patent No. 6,262,833 to Loxley et al. (hereinafter "Loxley"). (5/17/06 Office Action, p.5). Claim 12 is also rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Jacobson in view of U.S. Patent No. 6,611,100 to Moore (hereinafter "Moore"). (5/17/06 Office Action, p.5).

By this paper, Applicant has amended claim 6, added claims 14-17, and cancelled claims 1-5 and 12 without prejudice or disclaimer. Support for the amendment to claim 6 is found throughout the application as originally filed, for example, in the Specification page 11, line 6 to page 12, line 8. Support for new claims 14-17 are found throughout the application as originally filed, for example, as follows:

Claim 14: Example 1 of the Specification,

Claim 15: Example 2 of the Specification,

Claim 16: Example 3 of the Specification, and

Claim 17: Embodiment 5 of the Specification and Figure 5.

No new matter is introduced. Entry is respectfully requested.

B. Claims 1-13 are Patentably Distinct from the Cited References

Applicant respectfully traverses the §102(b) rejections of claims 1, 2, 6-11 and 13. Applicant has canceled claims 1 and 2 and thus rendering the §102(b) rejections of these claims moot. As discussed below, Jacobson cannot anticipate claims 6-11 and 13 because it does not teach, disclose or suggest all of the limitations of Applicant's independent claim 6.

Claim 6, as amended, recites:

A process for producing an electrophoretic display by using electrophoretic particles and a dispersion medium and/or a color filter as optical modulation members, comprising steps of:
providing one of said optical modulation members with a dye which is to be colored by an energy beam,
confining said dispersion medium and said electrophoretic particles in a plurality of spaces on a substrate, and
coloring said one of optical modulation members a color of said dye by applying said energy beam to selected spaces.

Claim 6 is directed to a process for producing an electrophoretic display including the step of coloring an optical modulation member a color of a dye by applying an energy beam to selected spaces. The Office Action recognizes that "Jacobson does not teach the colored member containing a dye which is colored by at least the external stimulus." (May 17, 2006 Office Action, 5). Jacobson is directed to electrophoretic displays using nanoparticles and discloses a coloring step in which nanoparticles can be colored a predetermined color by applying a strong electric field. Specifically, Jacobson describes a leuco dye group and a reducing agent group linked by a polymeric filament such that the leuco dye and the reducing agent are brought into proximity to form a bond, effecting a first colored state, and upon applying an AC electric field, the polymeric filament is in an open state where the leuco dye

group and the reducing agent group are no longer proximal, effecting a second colored state. (Jacobson, col. 18, line 26 to col. 19, line 13). Jacobson does not teach or suggest a coloring step using an energy beam.

For at least the reasons stated above, Applicants respectfully submit that claim 6 and claims 7-11 and 13, which depend therefrom, are patentable over Jacobson and respectfully request the §102(b) rejections be withdrawn.

Applicants have canceled claims 3-5 and 12 and thus rendering the §103(a) rejections of these claims moot. However, in the interest of expediting the prosecution of this application, Applicant will now address the Examiner's §103(a) rejections in view of the amended claims.

As discussed above, Jacobson fails to disclose a step of coloring an optical modulation member a color of a dye by applying an energy beam to selected spaces. However, the Examiner contends that:

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jacobson's display device to include a dye of which the color can be changed by an optical stimulus, as taught by Loxley to provide additional means / method to change the colors of the images to be displayed in a display, and thus to increase the reliability of the device. (5/17/06 Office Action, p.5).

Applicants respectfully disagree. Applicants note that Jacobson describes means for changing the color of an electrophoretic display by utilizing nanoparticles responsive to an electric field. Nowhere does Jacobson, Loxley or Moore mention the need to increase the reliability of the device. On the contrary, Jacobson describes a five-color system, comparable to the conventional CMYK printing on paper for rendering realistic full color images, using

multiple superimposed layers of microcapsules responsive to electric fields. (Jacobson, col. 15, lns. 35-54). Jacobson provides a complete solution for rendering realistic full color images using nanoparticles responsive to an electric field. Thus, Jacobson would not suggest or motivate one skilled in the art to increase the reliability of the device. Moreover, Jacobson does not mention coloring using an energy beam of any form. Based on at least these observations, one cannot conclude *a priori* that the combination of Jacobson and Loxley or Jacobson and Moore teach a process for producing an electrophoretic display including the step of coloring an optical modulation member a color of a dye by applying an energy beam to selected spaces, unless one were to use improper hindsight reconstruction.

In sum, the proposed combination of Jacobson with Loxley and the proposed combination of Jacobson with Moore are products of impermissible hindsight reconstruction based on Applicants' own invention. For at least the reasons discussed above, it is respectfully submitted that Applicants' claims are patentable over Jacobson in view of either Loxley or Moore and respectfully request the §103(a) rejections be withdrawn.

Appl. No. 10/696,176
Paper dated August 17, 2006
Reply to Office Action dated May 17, 2006

CONCLUSION

For the above-stated reasons, this application is respectfully asserted to be in condition for allowance. An early and favorable examination on the merits is requested. In the event that a telephone conference would facilitate the examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED FOR THE TIMELY CONSIDERATION OF THIS AMENDMENT UNDER 37 C.F.R. §§ 1.16 AND 1.17, OR CREDIT ANY OVERPAYMENT TO DEPOSIT ACCOUNT NO. 13-4500, ORDER NO. 1232-5185.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: August 17, 2006

By:



Wan Chieh Lee
Registration No. 57,297

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.
3 World Financial Center
New York, NY 10281-2101
(212) 415-8700 Telephone
(212) 415-8701 Facsimile